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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,948	10/24/2001	Sharon Michelle Darwent	YOR920000749US2	8859

7590 06/06/2005

IBM CORPORATION  
INTELLECTUAL PROPERTY LAW DEPT.  
P.O. BOX 218 - 39-238  
YORKTOWN HEIGHTS, NY 10598

EXAMINER
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JONES, HUGH M

ART UNIT	PAPER NUMBER
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2128

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/001,948

Applicant(s)

DARWENT ET AL.

Examiner

Hugh Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-101 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-101 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-101 of US Application 09/922,250, filed 8/6/2001, are presented for examination.

#### **Claim Objections**

2. Claims 33, 58, 67-68 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims not been further treated on the merits.

3. Claims 13-40, 51, 58, 68 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims not been further treated on the merits.

4. Claims 50-51 are objected to under 37 CFR 1.75(c) as being in improper form because claim **50** depends on claim 49 or **50**. See MPEP § 608.01(n). Claim 51 inherits the defect. Therefore, claims 50-51 have not been examined.

5. In summary claims 13-40, 50-51, 58, 67-68 have not been examined due to improper multiple dependencies.

#### **Information Disclosure Statement**

6. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be

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submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

7. Please provide the incorporated references (pp. 8-9 of the specification), in order that they may be reviewed.

**Claim Rejections - 35 USC § 112**

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-101 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claims 1-101 mix two statutory classes and are therefore ambiguous.

11. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. Claim 1 does not appear to recite a limitation. This claim is an omnibus type claim.

12. Claim 2 provides for the use of "narrative patterns", but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

13. Claim 2 is also rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results

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in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

14. Claim 3 recites "...in such a way as to be useful to the overall process...". It is not clear which process is claimed and the meaning of "in such a way" is ambiguous. The claim also recites "... in which various preparatory, selective, exploratory and purpose setting activities are carried out as needed." "Various" and "carried out as needed" are ambiguous.

15. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They are replete with grammatical and idiomatic errors. For example, the meaning implied by use of quotation marks throughout the claims is unknown. Furthermore, the use of parenthesis's does not conform with standard US claim drafting practice.

16. Regarding claim 7, 17, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

17. Regarding claims 21, 23, 41, the phrase "and the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "and the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

18. Claim 42 recites "any of the important dimensions of sensemaking", but does not recite what the dimensions are.

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19. Claim 57 recites "typically, people or groups". This is an ambiguous phrase.

20. Claim 100 recites "and possibly...", which is ambiguous.

Regarding claims 26, 28, 41, 89, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

21. Claims 1-101 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

### **No Prior Art Claim Rejections**

22. The claims have not been examined with respect to prior art in view of the numerous issues relating to indefiniteness and claim structure. See *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions).

### **Conclusion**

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Taylor et al. disclose a system and method for addressing the paradoxes and problems associated with the Knowledge Economy, and the transition to it. The system and method of the present invention create a unified experience of work that scales from individual thought processes to the building and using of a

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global system of commerce. Described in several levels of recursion, the system and method of the present invention integrate, into a single system and method several discrete Sub-Systems and methods that comprise a myriad of now unintegrated tools and processes that are conducted across contradictory and non-collaborative environments.

24. Any inquiry concerning this communication or earlier communications from the examiner should be:

**directed to:**

Dr. Hugh Jones telephone number (571) 272-3781, Monday-Thursday  
0830 to 0700 ET,

**or**

the examiner's supervisor, Jean Homere, telephone number (571) 272-  
3780.

Any inquiry of a general nature or relating to the status of this application  
should be directed to the Group receptionist, telephone number (703) 305-  
3900.

**mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-9051 (for formal communications intended for entry) **or**

(703) 308-1396 (for informal or draft communications, please label  
*PROPOSED* or *DRAFT*).

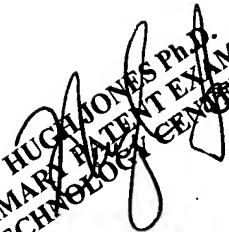
Application/Control Number: 10/001,948  
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Dr. Hugh Jones

Primary Patent Examiner

May 27, 2005

  
HUGH JONES Ph.D.  
PRIMARY PATENT EXAMINER  
TECHNOLOGY CENTER 2128